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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,049	07/25/2001	Andreas Dieberger	YOR9-2001-0385 (8728-520)	6021
46069	7590	03/23/2006	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/915,049	Applicant(s) DIEBERGER ET AL.	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 – 13, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is that claim 1 recites in the preamble: “a method for displaying content on a display device”. However, no step in the body of the claim indicates that the content is ever displayed.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 20 and 21 are rejected under 35 U.S.C. 101 because they are not directed to patentable subject matter that produces a useful, concrete and tangible result. In order to meet the tangibility requirement there must be a step that provides completion of the claimed method. In claim 1, the applicant is describing a method for displaying content. However, no content is ever provided during execution of the claimed steps. Therefore, no tangible result is ever provided.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 9, and 13 - 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (U.S. Patent Number: 6,060,993).

Claim 1: Cohen discloses a method for displaying content on a display device:

- a. Retrieving a plurality of rules for the display of content. (Col 4, lines 37 – 46)
- b. Updating a plurality of device parameters. (Col 4, lines 14 – 26)
- c. Determining a rule trigger. (Col 4, lines 54 – 60; and Col 4, line 64 through Col 5, line 3)
- d. Executing a rule corresponding to the rule trigger. (Col 4, lines 54 – 60; and Col 4, line 64 through Col 5, line 3)
- e. Determining a fee according to at least one device parameter upon executing a rule for the display of content. (Col 5, lines 10 – 23)

Claim 2: Cohen discloses the method of claim 1, wherein at least one rule is defined by a content provider to dynamically control the display of the content according to the device parameters. (Col 5, lines 10 – 23)

Claim 3: Cohen discloses the method of claim 1, wherein the step of executing a rule further comprises the step of receiving a rule trigger from one of a location handler and a signal handler. (Col 4, lines 54 – 60)

Claim 4: Cohen discloses the method of claim 3, wherein the step of receiving a rule trigger from the location handler further comprises the step of updating a positional parameter. (Col 4, lines 54 – 60)

Claim 5: Cohen discloses the method of claim 3, wherein the step of receiving a rule trigger from the signal handler further comprises the steps of:

- a. Interpreting an input signal (Col 5, lines 15 – 26)
- b. Generating a programmatic event flag (Col 4, lines 54 – 60)

Claim 6: Cohen discloses the method of claim 5, wherein the step of generating a programmatic event flag further comprises the step of generating one of a reply signal and the rule trigger. (Col 4, lines 54 – 60)

Claim 7: Cohen discloses the method of claim 1, further comprising the step of providing an overriding rule blocking the display of content corresponding to the rule and the determination of the fee, wherein the overriding rule is defined by the device owner. (Col 5, lines 10 – 23)

Claim 8: Cohen discloses the method of claim 1, wherein the step of determining a fee further comprises the steps of:

- a. Determining a value for each of the device parameters (Col 1, lines 22 – 45; and Col 5, lines 10 – 23)
- b. Determining at least one device parameter satisfying the rule (Col 1, lines 22 – 45; and Col 5, lines 10 – 23)
- c. Determining the fee according to value of the device parameters satisfying the rule. (Col 1, lines 22 – 45; and Col 5, lines 10 – 23)

Claim 9: Cohen discloses the method of claim 8, further comprising the step of charging the fee to a client providing content to be displayed. (Col 5, lines 10 – 23)

Claim 13: Cohen discloses the method of claim 1, wherein the fee is charged to a user for the use of the display. (the user is the advertiser using the service) (Col 5, lines 10 – 23)

Claim 14: Cohen discloses a method for displaying content on a mobile display device:

- a. Retrieving a plurality of rules stored in the mobile display device from a rule server. (Col 4, lines 37 – 46)
- b. Determining a value for each of a plurality of device parameters. (Col 1, lines 22 – 45; and Col 5, lines 10 – 23)
- c. Determining an rule trigger calling at least one rule. (Col 4, line 54 through Col 5, line 3)
- d. Determining whether each rule is satisfied by the device parameters. (Col 4, line 54 through Col 5, line 3)
- e. Displaying content corresponding to each satisfied rule. (Col 4, line 54 through Col 5, line 3)
- f. Determining a monetary charge based on the device parameters satisfying each rule. (Col 2, lines 22 – 45; and Col 5, lines 10 – 23)

Claim 15: Cohen discloses the method of claim 14, wherein at least one rule is defined by a content provider to dynamically control the display of the content according to the device parameters. (Col 5, lines 10 – 23)

Art Unit: 3622

Claim 16: Cohen discloses the method of claim 14, further comprising the step of receiving a rule trigger from one of a location handler and a signal handler. (Col 4, lines 54 – 60)

Claim 17: Cohen discloses the method of claim 16, wherein the step of receiving a rule trigger from the location handler further comprises the step of updating a positional parameter. (Col 4, lines 54 – 60)

Claim 18: Cohen discloses the method of claim 16, wherein the step of receiving a rule trigger from the signal handler further comprises the steps of:

- a. Interpreting an input signal. (Col 4, lines 15 – 26)
- b. Generating a programmatic event flag. (Col 4, lines 54 – 60)

Claim 19: Cohen discloses the method of claim 18, wherein the step of generating a programmatic event flag further comprises the step of generating one of a reply signal and the rule trigger. (Col 4, lines 54 – 60)

Claim 20: Cohen discloses a program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform method steps for displaying content on a display device, the method steps comprising:

- a. Retrieving a plurality of rules for the display of content. (Col 4, lines 37 – 46)
- b. Updating a plurality of device parameters. (Col 4, lines 14 - 26)
- c. Determining an rule trigger. (Col 4, line 54 through Col 5, line 3)
- d. Executing a rule corresponding to the rule trigger. (Col 4, line 54 through Col 5, line 3)

Art Unit: 3622

- e. Determining a fee according to at least one device parameter upon executing a rule for the display of content. (Col 5, lines 10 – 23)

Claim 21: Cohen discloses the program storage device of claim 18, wherein the method step of determining a fee further comprises the steps of:

- a. Determining a value for each of the device parameters. (Col 1, lines 22 – 45; and Col 5 lines 10 – 23)
- b. Determining at least one device parameter satisfying the rule. (Col 1, lines 22 – 45; and Col 5 lines 10 – 23)
- c. Determining the fee according to value of the device parameters satisfying the rule. (Col 1, lines 22 – 45; and Col 5 lines 10 – 23)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen (U.S. Patent Number: 6,060,993).

Claims 10 and 11: Cohen discloses the method of claim 8, further comprising the step of apportioning fees. However, Cohen is silent with regard to various permutations in which fee apportionment might entail. The teachings of Cohen describe the display system itself and not who owns and operates the display

system. It would have been obvious to one of ordinary skill in the art at the time of the invention that the service provider (entity that runs, operates and/or owns the display device) would need to reimburse the third party carrier (i.e. taxi company, trucking company, etc) for allowing them to put the display on the carrier's physical property (i.e. taxi cabs, trucks, buses, etc.). One would have been motivated to institute such a reimbursement in order to provide the third party carrier with an incentive to install the display to help in the defrayment of operating costs.

Claim 12: Cohen discloses the method of claim 8, further comprising the step of apportioning the fees. However, Cohen is silent with regard to various permutations in which fee apportionment might entail. The teachings of Cohen describe the display system itself and not who owns and operates the display system. It would have been obvious to one of ordinary skill in the art at the time the invention was made that when the device is sold as a stand alone device, in which various third party carriers (i.e. Taxi companies, trucking companies, etc.) can purchase and install, a fee would need to be paid to the plurality of owners, by the service provider (entity that operates the advertisement distribution hardware), in order to be provided the opportunity to display advertisements on their mobile display unit. One would have been motivated to provide such a reimbursement in order to maximize the number of display units on which it can provide advertisements, and as a result maximize the fees it charges to entities wishing to advertise on the service.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cohen (U.S. Patent Number: 6,236,330), which is a continuation in part of the patent, used in the office action and discloses similar features to those present in the claims.

Shear et al. (U.S. Patent Number: 6,112,181) which discloses distributed advertising including location specific nowcasting.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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